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| 10/719,063      | 11/24/2003  | David W. Nelson      | 36729-198472        | 9139             |

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| EXAMINER |
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ROWAN, KURT C

| ART UNIT | PAPER NUMBER |
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3643

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/719,063

**Applicant(s)**

NELSON, DAVID W.

**Examiner**

Kurt Rowan

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Terminal Disclaimer*

1. The terminal disclaimer filed on Jan. 3, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,651,379 has been reviewed and is NOT accepted.

a. The application/patent being disclaimed has not been identified. Both patents 6,185,862 and 6,651,379 must listed in the disclaimer.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No.

6,185,862. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious in view of the previously patented claims since, for example, the present application recites a planar sheet covered with an

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adhesive. Claims 1-3 of the prior patent recite a planar sheet covered with an adhesive so that the planar sheet can engage an insect.

3. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,651,379. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious in view of the previously patented claims since the same structural elements are recited such as, for example both claim independent claim recite a planar sheet substrate having a top and bottom side, the substrate has an adhesive disposed on an area of the top side, the substrate is of a compressible and pliable material and that the sheet is manually manipulated so that when the engagement areas of the top side cover an insect and a force is manually applied to the substrate from the bottom side, the insect will cause the substrate to collapse and form a concave depression which conforms to the shape of the insect.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 9, 11, 12, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hughes.

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The patent to Hughes shows a device for retraining pests comprising a planar sheet 13 having top side, a bottom side and an engagement area with adhesive as shown in Fig.

1. Hughes shows the structure capable of performing the intended use. Hughes shows a rigid support means 12 similar to a conventional cardboard index card. The substrate will collapse and form a concave depression which conforms to the shape of the pest or insect noting Fig. 4 of Hughes as a user wraps the substrate around the pest.

6. Claims 1-3, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by "Post-It" notes.

The commercially available "Post-It" notes shows a planar sheet substrate having a top side and a bottom side with an adhesive displaced on an engagement area of the top side. The substrate further comprises a compressible and pliable material. The "Post-It" note shows the structure to perform the function of catching an insect by manipulating the sheet. Also, as stated above in reference to Hughes, wrapping the "Post-It" note around an insect by exerting a force on the bottom side will cause the substrate to collapse and form a concave depression in the shape of the pest and therefor partially embed the pest within the substrate.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 2-3, 5-6, 7-8, 10, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes.

The patent to Hughes shows an adhesive sheet as discussed above. In reference to claims 2-3, it is not clear that the adhesive relied by Hughes has adhesive properties similar to conventional household transparent tapes or that of "Post-It" notes. However, it would have been obvious to employ an adhesive similar to a conventional transparent adhesive tape since the function is the same and no stated problem was solved. In reference to claim 17, it is not clear if the substrate is hydrophilic, but it would have been obvious to make the substrate hydrophilic for the purpose of having an affinity for the liquids (water) of an insect so they will be absorbed by the substrate when the insect is crushed.

9. Claims 13, 14, 15, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes as applied to claim 1 above, and further in view of EP 0 367 539 (Sherman).

The patent to Hughes shows a pest trap as discussed above and does not show the adhesive dispersed over the engagement area in a discontinuous manner. The EP patent to Sherman shows an adhesive 110 dispersed over a substrate in a discontinuous manner as shown in Figs. 4 and 8. In reference to claim 13, it would have been obvious to disperse the adhesive over a the substrate in a discontinuous manner as shown by Sherman since the function is the same and no stated problem is solved. In reference to claim 14, Hughes shows a flat planar sheet as shown in Fig. 2 with an engagement layer as shown in Fig. 4. Sherman shows the engagement area

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recessed with respect to the inherently compressible material 114 noting Fig. 6. In reference to claim 15, Sherman shows a striped pattern in Fig. 4. In reference to claim 16, Sherman shows a series of circular regions 110 in Fig. 8 as the engagement area with adhesive 110.

10. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes in view of EP '539 (Sherman) as applied to claim 14 above, and further in view of Shuster et al.

The patents to Hughes and Sherman show pest and insect traps and have been discussed above. Hughes shows applying pressure to the rear of the substrate as the sheet is folded over the pest in Fig. 4. Hughes does not disclose that the non-adhesive surface is displaced. Shuster shows an insect trap having a substrate 26 having an adhesive coating 22 and a compressible material 28 which the substrate is mounted on and which is displaced when an insect is pressured from the bottom side of the substrate. In reference to claim 19, it would have been obvious to provide the trap of Hughes as modified by EP '539 (Sherman) with the method shown by Shuster et al. for the purpose of capturing the insect by employing a compressible material to retain the insect without rupturing the insect body.

### ***Response to Arguments***

11. Applicant's arguments filed January 3, 2005 have been fully considered but they are not persuasive. Applicant argues that the Hughes trap does not require the intervention of a user in reference to claims 1 and 19. However, as shown in Fig. 4 of Hughes, a user is intervening to fold up the substrate around the pest. As far as a

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releasable adhesive allowing the pests to escape, one skilled in the art would tend to select an adhesive that would not permit the escape of the target species. In response to applicant's argument that there is no suggestion to provide Hughes with a hydrophilic substrate, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art since paper towels and their uses are known to those skilled in the art and a squashed insect would present the same problems that a paper towel is used to solve. Applicant has submitted no evidence to support the statement that the Hughes patent would require that the distribution of adhesive would have to be altered. The coating 110 of Sherman can be considered as an adhesive for some insects since its high viscosity could act as a trap. Even assuming that Sherman and Hughes operate in fundamentally different manners, one skilled in the art would seek to combine both so that pests that are not trapped can be killed. This is merely maximizing pest control strategies. Also, the leading edge of Sherman can be considered to be compressible to some degree since even molded plastic can be compressed and deformed. Why would one not employ the traps of Hughes and Sherman to trap an insect? As to Shuster, applicant states that the trap does not allow the substrate to conform to the insect. However, see column 1, lines 34-



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35 which state the pad constitutes a resilient support to avoid squashing the insect.

Hence the pad of Shuster conforms to the insect.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is 703 308-2321. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kurt Rowan", with a stylized flourish at the end.

Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR